

REMARKS

This Amendment is filed in response to the Office Action dated August 25, 2004, which has a shortened statutory period set to expire November 25, 2004. A three-month extension, extending the period of response until February 25, 2004, is requested in a petition filed herewith.

Specification and Figures

The Examiner notes that no drawing was filed with the present application. New FIGS. 1 and 2 are filed herewith for clarification purposes. Support for FIG. 1 is found in the specification as originally filed at least at page 4, lines 9-13. Support for FIG. 2 is found in the specification at least at from page 8, line 18 through page 9, line 7. No new matter is added. The specification is amended as described above to properly reference the new figures. No new matter is added. Note that a computer-aided design (CAD) tool inherently includes instructions for a computer.

The Examiner further notes that the "title of the invention should be descriptive and technically accurate." Applicants respectfully submit that the current title ("METHOD FOR CREATING INCENTIVES FOR A CAD TOOL VENDOR") is both descriptive and accurate. Should the Examiner still require an amendment to the title, Applicants respectfully request specific guidance from the Examiner as to the non-descriptive or inaccurate portions of the current title.

The Examiner further notes that "the abstract of the disclosure should be descriptive." Accordingly, a replacement abstract (as described above) is included herein to provide greater description of the invention described within the specification.

Claim Objections

Claims 1-13 are objected to for a variety of informalities. Claims 1-13 are cancelled, thereby rendering these objections moot.

Rejections Under 35 U.S.C. 101

Claims 1-11 and 13 stand rejected under 35 U.S.C. 101 as being directed towards non-statutory subject matter. Claims 12 and 13 stand rejected under 35 U.S.C. 101 as not producing any concrete, useful, and tangible result. Claims 1-13 are cancelled, rendering these rejections moot.

Double Patenting

Claims 9 and 10 stand provisionally rejected under 35 U.S.C. 101 as claiming the same invention as Claims 7 and 8, respectively. Claims 7-10 are cancelled, rendering these provisional rejections moot.

Rejections Under 35 U.S.C. 112

Claims 1-13 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. Claims 1-13 are cancelled, rendering these rejections moot.

Claim 13 stands rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements. Claim 13 is cancelled, rendering this rejection moot.

Rejections Under 35 U.S.C. 102

Claims 1-13 stand rejected under 35 U.S.C. 102(b) as being anticipated by PCT Patent Application PCT/F197/00685 from Philip

Ginzboorg et al., published as International Publication No. WO 98/21676 on May 22, 1998 (hereinafter "Ginzboorg"). Claims 1-13 are cancelled, rendering these rejections moot.

New Claims

New Claims 18-25 are added in the present paper. Support for these new claims is found in the specification as originally filed at least at page 4, lines 9-10, page 7, lines 10-16, and page 8, line 18 through page 9, line 7. No new matter is added. Applicant respectfully submits that new Claims 18-25 comprise statutory subject matter and are patentable over the reference cited by the Examiner (i.e., Ginzboorg).

For example, new Claim 18 recites:

A computer-readable medium encoded with a software tool for instructing a computer to generate an output file, the software tool comprising an instruction for the computer to add a watermark to the output file for identifying the output file as having been produced by the system. (Emphasis added.)

Support for Claim 18 is found in the specification as originally filed at least at page 8, line 18 through page 9, line 3. No new matter is added (note that a software tool, such as a CAD tool, is inherently encoded on a computer-readable medium and also inherently includes instructions for controlling the operation of a computer). Adding a tool-specific watermark to an output file beneficially "allows the CAD company to monitor usage by the designer ... [by] audit[ing] the work product of the designer, looking for usage of the CAD tools."

(Specification as originally filed, page 8, lines 15-18.)

Claim 18 recites "A computer-readable medium encoded with a software tool ... comprising an instruction for the computer to add a watermark to the output file", and therefore is directed towards "produc[ing] a 'useful, concrete, and tangible result'

... [that] renders it statutory subject matter", as noted by the Federal Circuit in State Street Bank & Trust Co. v. Signature Financial Group, 149 F.3d 1368, 1375. Accordingly, Claim 18 is allowable under 35 U.S.C. 101. Claims 19-22 depend from Claim 18 and are therefore also allowable under 35 U.S.C. 101.

Claim 18 is further allowable under 35 U.S.C. 102(b) over Ginzboorg, as Ginzboorg does not teach or suggest "an instruction for the computer to add a watermark to the output file" as recited in Claim 18. Rather, Ginzboorg teaches a system for "us[ing] centralized charging for billing multimedia services" (Ginzboorg, page 4, line 7) such as "Video-on-Demand service via the Internet" (Ginzboorg, page 7, lines 14-15). Thus, Ginzboorg does not provide any impetus for implementing "an instruction for the computer to add a watermark to the output file" as recited in Claim 18, Ginzboorg is directed towards distributing, rather than creating, content. For at least this reason, Claim 18 is allowable over Ginzboorg under 35 U.S.C. 102(b). Claims 19-22 depend from Claim 18 and are therefore allowable under 35 U.S.C. 102(b) for at least the same reasons that Claim 18 is allowable. Accordingly, Applicants respectfully request consideration and allowance of new Claims 19-22.

New Claim 23 recites:

A computer-readable medium encoded with an integrated circuit (IC) design file comprising a watermark, the watermark identifying the IC design file as having been produced by computer aided design (CAD) tools from a particular CAD company. (Emphasis added.)

Support for Claim 23 is found in the specification as originally filed at least at page 8, line 18 through page 9, line 3. No new matter is added (note that the output of a CAD (**computer-aided design**) tool is inherently encoded on a computer-readable medium). As noted on page 9 of the USPTO "Examination

Guidelines for Computer-Related Inventions"
(<http://www.uspto.gov/web/offices/com/hearings/software/analysis/files/guides.doc>) :

[A] claimed **computer-readable medium encoded with a computer program** defines structural and functional interrelationships between the computer program and the medium which permit the computer program's functionality to be realized, and **is thus statutory.** (Emphasis added.)

Accordingly, Claim 23 is allowable under 35 U.S.C. 101. Claims 24 and 25 depend from Claim 23, and are therefore also allowable under 35 U.S.C. 101.

As noted above with respect to Claim 18, Ginzboorg does not teach or suggest a "**watermark** identifying the IC design file as having been produced by computer-aided design (CAD) tools from a particular CAD company" (emphasis added) as recited by Claim 23. In fact, Ginzboorg does not mention or suggest an "IC design file" or "computer-aided design (CAD) tools" as recited by Claim 23. For at least these reasons, Claim 23 is allowable under 35 U.S.C. 102(b) over Ginzboorg. Claims 24 and 25 depend from Claim 23, and are therefore allowable under 35 U.S.C. 102(b) for at least the same reasons the Claim 23 is allowable.

Accordingly, Applicants respectfully request consideration and allowance of Claims 23-25.

CONCLUSION

Claims 18-25 are pending in the present Application.
Allowance of these claims is respectfully requested.

If there are any questions, please telephone the
undersigned at 408-451-5903 to expedite prosecution of this
case.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited
with the United States Postal Service as FIRST CLASS MAIL in
an envelope addressed to: Mail Stop Amendment, Commissioner
for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on
February 14, 2005.

2/14/2005
Date

Rebecca A. Baumann
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AMENDMENTS TO THE FIGURES

New drawing sheets adding FIGS. 1 and 2 are included herewith.